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| APPLICATION NO.       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION N |
|-----------------------|-------------|----------------------|---------------------|----------------|
| 10/699,310            | 10/31/2003  | Lisa B. Carvajal     | Carvajal 101        | 3929           |
| 7590                  | 10/27/2004  |                      |                     |                |
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|                       |             |                      | EXAMINER            |                |
|                       |             |                      | FERNSTROM, KURT     |                |
|                       |             | ART UNIT             | PAPER NUMBER        |                |
|                       |             | 3714                 |                     |                |

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/699,310

Applicant(s)

CARVAJAL, LISA B.

Examiner

Kurt Fernstrom

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,11,16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11,16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-8, 11, 16, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites a soft outer edge. Claim 8 recites that the rubber is foam rubber. Claim 19 recites that the outer edge does not have a rigid or steel rim. None of these limitations are described in the specification as originally filed. As a result, claims 1, 8 and 19, and all claims dependent therefrom, are rejected under 35 U.S.C. 112, first paragraph.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Peters. Peters discloses in Figure 1 and in column 2, line 66 to column 3, line 16 a portable device comprising a circular mat comprising a soft rubber material 11 and a layer of fabric 12 laminated thereon which is flexible for folding. As best shown in Figure 6, the layer of fabric extends over the outer edge into a hem 14; therefore, the outer edge of the mat is soft, bearing in mind that "soft" is a relative term. As shown in Figures 1 and 2, the mat of Peters has no seams or creases.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Chang. Pascal discloses all of the limitations of the claims with the exception of the decorative indicia, including indicia in the form of a cartoon character. Chang discloses a mat having indicia thereon representing a cartoon character. It would have been obvious to one of ordinary skill in the relevant art to modify the device

disclosed by Peters by providing decorative indicia in the form of a cartoon character thereon for the purpose of making the mat more attractive to a child.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Yamasaki. Pascal discloses all of the limitations of the claims with the exception of the fabric being polyester. However, polyester is a well known type of fabric, and is a known material to use in sitting mats, as disclosed for example by Yamasaki. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Peters by providing polyester for the purpose of providing a comfortable yet durable fabric material for sitting. Further, polyester appears to be an arbitrary variation on the LYCRA material disclosed by Peters, being similar materials and having essentially the same function.

Claims 6, 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters. Peters discloses all of the limitations of claims 6 and 7 with the exception of the claimed diameter and thickness. From the Figures, it appears that the diameter and thickness are within the claimed ranges. To the extent that the Figures do not explicitly disclose the claimed diameter, such diameter would have been an obvious variation for the purpose of providing a mat which can be more easily used by children. To the extent that the Figures do not explicitly disclose the claimed thickness, such thickness would have been an obvious variation for the purpose of providing a mat which can be easily folded. Peters discloses all of the limitations of claim 16 with the exception of the use of TBD. Given that Peters discloses that the material is rubber, as discussed above, TBD would be an obvious variation on the material disclosed by Peters.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pascal in view of Peters. Pascal discloses in Figure 1 and in column 2, line 7 to column 3, line 31 a portable device comprising a shaped mat comprising a soft decorative material comprising plastic and fabric which is flexible for folding. The device of Pascal does not have a rigid or steel rim along the outer edge. Pascal fails to disclose that the mat comprises a piece of rubber having an upper fabric coating adhered thereto. Peters discloses in Figure 1 and in column 2, line 66 to column 3, line 16 a portable device comprising a circular mat comprising a soft rubber material 11 and a layer of fabric 12 laminated thereon which is flexible for folding. It would have been obvious to one of ordinary skill in the art to modify the device of Pascal by providing a piece of rubber having an upper fabric coating adhered thereto for the purpose of providing a more durable mat which can be used outdoors.

### ***Response to Arguments***

Applicant's arguments filed on July 22, 2004 have been fully considered but they are not persuasive. The amendments to claim 1 do not overcome the Peters reference. As discussed above, the mat of Peters has a soft outer edge. Also, this limitation was not described in the specification, and thus constitutes new matter.

Applicant's arguments with respect to claims 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 16, 2004

  
**KURT FERNSTROM**  
**PRIMARY EXAMINER**